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#9

08 JAN 1999

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In re Application of
GERHAEUSER et al
Application No.: 08/676,355
PCT No.: PCT/DE95/00055
Int. Filing Date: 16 January 1995
Priority Date: 19 January 1994
Attorney Docket No.: 960160
For: METHOD OF DETERMINING THE
RECEPTIVITY OF WIRELESS
SIGNALS IN A BROADCAST SYSTEM

DECISION ON PETITION

This is a decision on applicants' "Renewed Petition Pursuant to 37 C.F.R. 1.137(a)" filed in the Patent and Trademark Office (PTO) on 31 July 1998.

BACKGROUND

On 04 September 1996, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.63 was required.

On 23 September 1996, applicants filed a "Response to Notice of Missing Requirements 35 U.S.C. 371" which was accompanied by a copy of the Form PCT/DO/EO/905 and a copy of a cover letter which was allegedly filed 20 August 1996.

On 05 May 1997, applicants filed a petition under 37 CFR 1.181 which was accompanied by a copy of a declaration of the inventors and a copy of a postcard receipt. The petition requested that the declaration be accepted as having been filed with the PTO on 20 August 1996.

On 23 September 1997, this Office mailed a decision dismissing the petition on the grounds that the postcard was not sufficient to establish that the declaration had been previously filed in the present application. The decision also set forth that the declaration of the inventors was not acceptable in that it did not properly identify the application to which it was directed.

On 06 October 1997, applicants filed an initial petition under 37 CFR 1.137(a) requesting that the application be revived as having become abandoned due to an unavoidable delay which was accompanied by, inter alia, the requisite petition fee and a declaration of the inventors.

On 09 March 1998, this Office mailed a decision dismissing the petition on the grounds that applicant had not filed an acceptable showing of unavoidable delay, an acceptable declaration of the inventors, or the requisite terminal disclaimer and fee.

On 31 July 1998, applicants filed the present renewed petition which was accompanied by, inter alia, a petition and fee for a three month extension of time.

On 17 September 1998, applicants filed a newly executed declaration of the inventors.

DISCUSSION

First it should be noted that the decision mailed 09 March 1998, set forth a two month period for response and specifically set forth that "[a] proper response must include...an acceptable declaration of the inventors." However, a review of the application file reveals that: (1) the complete proper response was not filed until the submission of the newly executed declaration of the inventors on 17 September 1998; (2) applicants had previously filed a petition and fee to extend the period for filing a proper response until 09 August 1998; and (3) no further petition and fee for an additional extension of time accompanied the declaration. Therefore, the present renewed petition is properly dismissed as being untimely.

That having been said, it should be noted that even had the response to the prior decision been timely filed, it still could not have been properly granted. As set forth in the 09 March 1998 decision, a petition to revive an abandoned application under 37 CFR 1.137(a) must be filed promptly and be accompanied by: (1) an adequate verified showing

of the cause of the unavoidable delay; (2) a proposed response; (3) the petition fee required by law (37 CFR 1.17(l)); and (4) a terminal disclaimer and fee (if required under 37 CFR 1.137(c)). Applicants have now satisfied items (2) and (3) above.

With respect to item (1), applicants have failed to set forth a showing of any circumstances that would support a holding of unavoidable delay. Specifically, the arguments as to the unavoidable delay set forth in the present renewed petition appear to be directed to the question of whether the Form PCT/DO/EO/905 was properly mailed. However, as set forth in the decision mailed 23 September 1997, applicants have not presented sufficient evidence to establish that a declaration was filed in the present application prior to the mailing of the Form PCT/DO/EO/905, and a review of the present petition and accompanying papers reveals that such is still the case. Therefore, any arguments as to the unavoidable delay must be directed to the reason for abandonment of the application. Specifically, the present application became abandoned for failure to file a proper response to the Form PCT/DO/EO/905, and thus applicants must establish that the failure to file a declaration of the inventors in response to the Form PCT/DO/EO/905 requiring such was unavoidable. Presently applicants have not set forth how the failure to timely file a proper response to the Form PCT/DO/EO/905 in the form of a declaration of the inventors was unavoidable. It is noted that the present petition sets forth that the response filed 23 September 1996, included "copies of all of the previously submitted documents." However, a review of the application file reveals that the 23 September 1996 response was accompanied by only a copy of the Form PCT/DO/EO/905 and a copy of a cover letter which was allegedly filed 20 August 1996, but that it did not include a copy of the allegedly earlier filed declaration.

Finally, a review of the application file reveals that a terminal disclaimer and fee, as required under item (4) above, have still not been filed.

Therefore, in that a proper response to the 09 March 1998 decision was not timely filed, and in that items (1) and (4) above have not been satisfied, the petition still may not be properly granted.

CONCLUSION

For the reasons above, the petition is **DISMISSED** without prejudice.

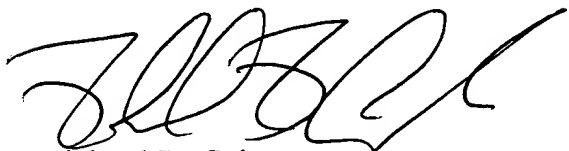
If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.137(a)". No additional petition fee is required.

A proper response must include an acceptable showing of unavoidable delay as discussed above. Such an explanation must also include an acceptable showing that the failure to timely file a proper response to the 09 March 1998 decision was also unavoidable. Further, a proper response must also include a terminal disclaimer and fee.

Extensions of time may be obtained under 37 CFR 1.136(a).

In the alternative, applicants may wish to consider the filing of a petition to revive based on unintentional delay under 37 CFR 1.137(b). Such a petition must be accompanied by, inter alia, the requisite petition fee, a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and a terminal disclaimer and fee. Additionally, given that the present response was not timely filed, such a petition must also include further information as to the cause of the delay in filing the present complete proper response without a petition and fee for a proper extension of time, and how such delay was "unintentional" (see the comments to the "Changes to Patent Practice and Procedure" published in the Federal Register on 10 October 1997, (62 Fed. Reg. 53131, 53159)).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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